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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,808	12/08/2003	Kia Silverbrook	ZG113US	8908

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AUSTRALIA

EXAMINER

MITCHELL, JAMES M

ART UNIT PAPER NUMBER

2813

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/728,808	<b>Applicant(s)</b> SILVERBROOK, KIA	
	<b>Examiner</b> James M. Mitchell	<b>Art Unit</b> 2813	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/12/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to applicant's amendment filed August 30, 2005.

#### ***Claim Objections***

2. Claim 4 depends on a canceled claim and is likewise canceled.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 4 and 6-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1, 2, 4 and 6-20 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Evidence that claims 1, 2, 4 and 6-20 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed August 30, 2005. In that paper, applicant has argued that forming the mold and wafer of the same composition were not obvious, because it correct the misalignment of caps compared to *silicon wafers*, and this statement indicates that the invention is different from what is defined in the claim(s) because it does not encompass the mold and wafer being formed from every known material/composition (e.g. glass/ metal/ semiconductor etc.).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 15, 16, 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is ambiguous in that while the claims indicate a process of halves “coming together” there is no affirmative recitation that the halves **are** brought together to impart. The confusion is also compounded, because the claim recites, “**when** the halves are brought together,” which suggests there has yet to be an affirmative claim made to apprise one of ordinary skill in the art the metes and bounds. Does the structure contain a material between the first and second halve? If so, what is the structure<sup>1</sup> that’s imparted?

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 7 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross et al. (U.S. 5,056,296).

10. Ross (Fig. 4A, 6A, 6B) discloses:

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(cl. 1) a separable two part mold (3a, 2a) and caps (8,53, 54), the mold comprising a first and second halves (3a,2a) when brought together defining mold cavities (e.g. space with caps therein), the mold cavities having a spacing which corresponds to a spacing provided on a wafer ( e.g. cap/lid for electronic package<sup>2</sup>; abstract); the mold caps having a shape (e.g. capable for forming caps<sup>3</sup>);

(cl. 7) and the first mold (3a) has a lower surface in which recess are formed (e.g. area taken by 53), the second (2a) half having upper surface in which grooves are formed (e.g. area taken by 54);

11. With respect to the intended use limitations of “mold for forming caps” and caps “to be attached to a wafer,” or shape “for forming,” the prior art forms the same structure as claimed. As such, the intended use limitation does not impart patentability, since it has been held that the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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<sup>1</sup> A claim that recites the material squeezed out could structurally embody an empty cavity.

<sup>2</sup> Electronic package is formed of part of wafer and therefore caps correspond to space on a wafer.

<sup>3</sup> Caps shown, 53, 54 surrounded by side walls of cavities; however caps have yet to affirmatively claims and are still part of the intended use limitation. See paragraph 8.

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2, 6, 11 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Ross et al. (U.S. 5,056,296).

14. Ross discloses the elements stated in paragraphs 7 and 8 of this office action, and further separate caps including thin layers/caps (53,54) between first and second halves, and recesses and grooves defining cavities for caps.

15. Ross does not show that mold material being for example a semiconductor. However forming the mold from a semiconductor would have been obvious, since it has been held that to be within the general skill of a worker in the art to select known material on the basis of its suitability for intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416 (CCPA 1960).

16. With respect to the product by process limitation of claims 6 and 16 for example, that the "mold cavities were formed using... etching techniques," or "when the halves are brought together<sup>4</sup>...." [E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

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<sup>4</sup> The scope of claim where material is squeezed out, creates cavities with no excess/ or material; no affirmative claim has been made where the structure includes material that was subsequently squeezed.

***Response to Arguments***

17. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Mitchell whose telephone number is (571) 272-1931. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead Jr. can be reached on (571) 272-1702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jmm  
December 11, 2005

*Carl Whitehead Jr.*  
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